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| APPLICATION NO.            | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|----------------------------|-------------|----------------------|---------------------|------------------|
| 09/787,982                 | 03/22/2001  | Herbert Ulrich       | 879.155USWO         | 1258             |
| 23552                      | 7590        | 08/13/2004           | EXAMINER            |                  |
| MERCHANT & GOULD PC        |             |                      | DEL SOLE, JOSEPH S  |                  |
| P.O. BOX 2903              |             |                      | ART UNIT            |                  |
| MINNEAPOLIS, MN 55402-0903 |             |                      | PAPER NUMBER        |                  |

1722

DATE MAILED: 08/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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|                              |                                |                                 |  |
|------------------------------|--------------------------------|---------------------------------|--|
| <b>Office Action Summary</b> | Application No.<br>09/787,982  | Applicant(s)<br>ULRICH, HERBERT |  |
|                              | Examiner<br>Joseph S. Del Sole | Art Unit<br>1722                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 July 2004.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 6-9 and 14-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6-9 and 14-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Specification*

1. The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

#### Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC (See 37 CFR 1.52(e)(5) and MPEP 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text are permitted to be submitted on compact discs.) or  
REFERENCE TO A "MICROFICHE APPENDIX" (See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.)
- (e) BACKGROUND OF THE INVENTION.
  - (1) Field of the Invention.
  - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (f) BRIEF SUMMARY OF THE INVENTION.
- (g) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (h) DETAILED DESCRIPTION OF THE INVENTION.
- (i) CLAIM OR CLAIMS (commencing on a separate sheet).
- (j) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (k) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

2. The disclosure is objected to because of the following informalities: **a)** the specification does not contain the subject headings as required above and should be

amended to include such therein; **b)** the specification lacks mention of the features of claims 7-9 (originally claimed as claims 2-4), each feature claimed should be in the specification; **c)** the specification does not include the terminology of the claims with regard to the "vacuum chamber" of claim 6, line 5 (and elsewhere), as claimed the feature matches the "vacuum bell" recited in the original disclosure; each feature claimed should be in the specification; **d)** the specification does not include the terminology of the claims with regard to the "predetermined diameter" of claim 6, line 9 (and elsewhere), as claimed the feature matches the "desired diameter" recited in the original disclosure; each feature claimed should be in the specification; and **e)** the specification does not include the terminology of the claims with regard to the "adjustable vacuum seal" of claim 6, line 16 (and elsewhere), as claimed the feature matches the "vacuum seal, which... adjusts automatically" recited in the original disclosure; each feature claimed should be in the specification.

Appropriate correction is required.

3. The amendment filed 2/20/04 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: "measuring instruments 12" which was added to line 6 of page 4. There is no support that the device indicated by reference numeral 12 in Figure 12 is a measuring instrument because **a)** the original disclosure indicates that the measuring instruments are not represented in the drawing; and **b)** the measuring instruments are claimed as controlling the outside diameter in a

touch-free manner (see original claim 3). The measuring instruments cannot both rest on the outside wall of the pipe (original claim 2) and control in a touch-free manner (original claim 3) and thus one reference numeral for a feature in Figure 2 cannot represent both types of instrument.

Applicant is required to cancel the new matter in the reply to this Office Action.

#### ***Claim Objections***

4. Claims 6 and 14 are objected to because of the following informalities: a) "bath" should be changed to --bathe-- at both line 14 of claim 6 and line 12 of claim 14 because it is used as a verb. Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 112***

5. Claims 6-9 and 14-17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Independent claims 6, 14 and 15 have added limitations regarding automatic control of devices based on a predetermined diameter. However there is no discussion in the original disclosure of automatic control of the calibrating station, vacuum calibrating bath, adjustable vacuum seal or support rollers based on predetermined diameter. Such incidences of new matter occur at claim 6, lines 10-12, 13-15, 16-18, claim 14, lines 15-17 and claim 15, lines 1-3. The Examiner reiterates the lack of "predetermined diameter" as terminology in the specification. However the closest match: "desired diameter" also does not

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provide automatic control of the devices as discussed herein. New matter exists also in claim 14, lines 9-14 because there is no support for "calibrating station configured to fit the outer surface of the melt column", "vacuum calibrating bath configured to fit the outer surface of the melt column" or "adjustable vacuum seal configured to fit the outer surface of the melt column".

### ***Response to Arguments***

6. Applicant's arguments with respect to claims 6-9 and 14-17 have been considered but are moot in view of the new ground(s) of rejection.

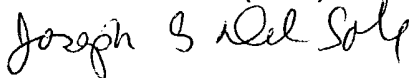
The Applicant's amendments to claims 6-9 and 14-17 have overcome the previous rejections and the claims are allowable over the prior art, however the claims contain new matter and are thus not allowed. Amending the claims to correct the new matter may result in non-allowability of the claims.

### ***Correspondence***

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Joseph S. Del Sole whose telephone number is (571) 272-1130. The examiner can normally be reached on Monday through Friday from 8:30 A.M. to 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Wanda Walker, can be reached at (571) 272-1151. The official fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306 for both non-after finals and for after finals.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from the either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on the access to the Private PAIR system, contact the Electronic Business Center (EBC) at 886-217-9197 (toll-free).



J.S.D.

August 11, 2004